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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,624	07/24/2003	Elizabeth A. Colbert	015291-112	8076
21839 7590 07/26/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT 1771	PAPER NUMBER
			MAIL DATE 07/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,624

Applicant(s)

COLBERT, ELIZABETH A.

Examiner

Ula C. Ruddock

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4-17-07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicant's response filed April 27, 2007. The rejection in view of Francis (US 3,839,141). It should be noted that the inclusion of the McKinnon reference was a typographical error and was not intended to be relied upon in the rejection.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 and 28-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 and 51-53 of copending Application No. 10/823428. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-19 and 28-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 19-27, 37-46, and 56-62 of copending Application No. 10/824193. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-19 and 28-31 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 51-53 of copending Application No. 10/824336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant has added claims 28-31 which disclose that the "coating is disposed on an entirety of the facing sheet." There is no support in the specification for this limitation and therefore, is considered new matter.

Claim Rejections - 35 USC § 103

9. Claims 1-7, 9, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103). Francis et al. disclose wallboard comprising a gypsum core sandwiched between paper facings (col 1, ln 9-10), wherein the paper facing is coated with a joint composition (col 1, ln 17-26). The joint composition comprises filler material, adhesive binder, and water. As seen in Table 1, water is present in the composition in the amount of 33.5-35.5% by weight. The preferred filler is gypsum or limestone (i.e. calcium carbonate) (col 5, ln 19-25) in the amount of 25-93% by weight (col 5, ln 21). Mica or talc are also added to the composition (col 4, ln 42) in the amount of 5-50%. The binder, which is latex (see col 2, ln 60), is present in the amount of 2-12% by weight. It should be noted that in claim 6 of the present invention, filler (0-30%) and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Also, in claim 9, limestone (0-50%), clay (0-10%), other fillers (0-30%), and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Francis et al. disclose the claimed invention except for the specific teaching that the coating penetrates through at least a portion of the facing sheet and into the gypsum core.

It would have been obvious to one having ordinary skill in the art to have the joint composition of Francis penetrate through the paper and into the gypsum core, motivated by the desire to create a wallboard material that has increased lamination strength and tear resistance. Because the same materials are being used as the facing sheet (paper) and coating (joint compound), the coating would penetrate therethrough.

Regarding claims 3 and 4, Francis et al. do not disclose the specific coating thickness. However, in the absence of unexpected results it would have been obvious to one having ordinary skill in the art to have made the thickness of the coating up to 30 mils or preferably 3-20 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In the present invention, one would have optimized the coating thickness motivated by the desire to create a wallboard material that has decreased delamination and increased strength.

Regarding claims 12, 13, 15, 18, although Francis does not explicitly teach the claimed level 4 or level 5 finish, it is reasonable to presume that this property is inherent to the invention of Francis. Support for said presumption is found in the use of like materials (i.e. gypsum board, paper facing, and a coating comprising water, gypsum or limestone, latex binder, clay or mica or talc, and other additives). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a facing sheet with a level 4 or level 5 finish, would obviously have been present once the Francis product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Rejection is maintained.

10. Claims 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103) in view of Zuber et al. (US 6,105,325). Francis et al. disclose the claimed invention except for the teaching that the composition comprises a pigment material and that the paper is an unbleached grey paper.

Zuber et al. (US 6,105,325) disclose a plasterboard material comprising a plaster body and at least one sheet of lining paper (i.e. facing) comprising a mineral filler of light color (abstract). The pigment layer comprises a white mineral filler (col 3, ln 60-63). In addition, one of the sheets of paper can be unbleached grey paper (col 3, ln 25-28). It would have been obvious to one having ordinary skill in the art to have used the pigment of Zuber in the composition of Francis, motivated by the desire to create a joint composition that has the desired tint. It also would have been obvious to one having ordinary skill in the art to have made the paper of Francis be the unbleached grey paper of Zuber, motivated by the desire to create a wallboard material that has cheaper manufacturing costs, due to not bleaching the paper.

Rejection is maintained.

Response to Arguments

11. Applicant's arguments filed April 27, 2007 have been fully considered but they are not persuasive for the reasons set forth. Applicant argues that the claim features result not only from certain elements used in the construction, but also from the methods disclosed in the specification by which the claimed boards are constructed and accordingly, the products result from a combination of the materials used and the methods by which they are assembled. This argument is not commensurate in scope with the present claims, which are drawn to product limitations, not

process limitations. Furthermore, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Applicant also argues that Francis' coating is applied to a dry board, whereas, in the present invention a diluted form of joint compound is applied to a wet form. These arguments are also not commensurate in scope with the claims because the claims do not specify whether the board is dry or wet. The claims also do not specify that the joint compound is regular or diluted. Accordingly, because Applicant is arguing limitations that are not in the claims, the arguments are not persuasive and the rejections are maintained.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR *UCR*

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